

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant:	Christian Zander	Docket No.:	7468 US
Serial No.:	10/692,504	Art Unit:	2179
Filed:	October 24, 2003	Examiner:	Phenuel S. Salomon
For:	Setting up a Procedure of a Communication Taking Place Between Instances Using a Protocol Tester		

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Dear Sir:

This Reply Brief is filed in connection with the appeal from the Examiner's final rejection of the above-identified application and, more particularly, in response to the Examiner's Answer mailed June 25, 2010.

**I. Summary of claim elements missing from the cited references**

The cited references fail to teach or suggest the following limitation of the pending claims and, therefore, the rejections should be withdrawn and the claims passed to issue.

**A. A message . . . which contains a variable . . .**

Claims 1 and 11 require defining (claim 1) or a means for defining (claim 11) "a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable." The Final Action admits that the Gessel reference fails to disclose this limitation, but cites the Matui reference as disclosing these limitations. The Swift reference is not cited in connection with these limitations. As discussed in the Appeal Brief at pages 7-9, the cited references do not teach or suggest a message containing a variable.

**B. A protocol tester performing one of several activities as a function of the content of the variable**

This limitation is a further requirement of the “variable” defined in claims 1 and 11. Claims 1 and 11 require defining (claim 1) or a means for defining (claim 11) “a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable.” The Final Action admits that the Gessel reference fails to disclose this limitation, but cites the Matsui reference as disclosing these limitations. The Swift reference is not cited in connection with these limitations. As discussed in the Appeal Brief at pages 7-9, the cited references do not teach or suggest several activities that are performed as a function of the variable content.

**C. Specifying a switch functionality**

Claim 2 requires “specifying a switch functionality which the other instance executes as a function of the content of the variable.” The Final Action identifies Matsui as teaching this limitation. As discussed in the Appeal Brief at pages 9-10, the cited references do not teach or suggest specifying the switch functionality that is required in claim 2.

**D. Specifying a loop functionality**

Claim 3 requires “specifying a loop functionality which the other instance executes as a function of the content of the variable.” The Final Action identifies Gessel as teaching this limitation. As discussed in the Appeal Brief at pages 10-11, the cited references do not teach or suggest specifying the loop functionality that is required in claim 3.

**II. Evolving grounds of rejection**

The rejection of claims 1 and 11 and, in particular, the citation of prior art allegedly disclosing the “message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable” has continued to evolve during the appeal process. Although the Matsui reference is the primary document cited as prior art for this feature, the Examiner has identified different, unrelated sections of Matsui in the Final Action, the Advisory Action, and the Examiner’s Answer in connection with this limitation. The following table lists the

various disclosures within the Matsui document that have been cited in connection with the “message variable” limitation quoted above. Appellant noted the changing grounds of rejection in the Appeal Brief at § VII.A. Now, in the Examiner’s Answer, the grounds of rejection have further changed.

USPTO paper	Cited Matsui disclosure for “message variable” limitation
Final Action at 4	Col. 1, lns. 58-65 Col. 2, lns. 10-14
Advisory Action at 2	Col. 5, lns. 19-24 <b>(new reference)</b> Figure 5, element 410 <b>(new reference)</b> Col. 7, lns. 54-58 <b>(new reference)</b>
Examiner’s Answer at 4, 8	Col. 1, lns. 58-65 Col. 2, lns. 10-14 Figure 1, elements 90 and 160 <b>(#90 new reference)</b> Figure 5, element 411 <b>(new reference)</b> Col. 5, “bottom” <b>(new reference)</b> Col. 6, “top” <b>(new reference)</b> Col. 7, [all] and lns. 50-60 <b>(portion outside lns. 54-58 is new reference)</b> Figure 6, element 90 <b>(#90 new reference)</b>

With respect to the new grounds of rejection identified in the Examiner’s Answer, Appellant provides the following remarks.

The Examiner’s Answer cites columns 1 and 2 and Figure 1 as discussing input/output unit 90. (Answer at 8). However, element 90 is not shown in Figure 1 and is not discussed in columns 1 or 2. Therefore, that citation and rejection is not supported by the reference itself.

The Answer further cites “new” element 411 in Figure 5. (*Id.*). Element 411 is a step of storing a created scenario or message in a scenario buffer 60 or a message buffer 70. (Matsui, col. 7, lns. 10-11). The Answer alleges that the format of a message stored in the buffer is “Name, format conversion, parameter analysis, sequence flow, information analysis, protocol adaptability etc.” (Answer at 8, citing Matsui col. 5 “bottom” and col. 6 “top”). However, the cited portion of the disclosure (i.e. text overlapping columns 5 and 6) does not

correspond to buffers 60/70 in which the scenario/message is stored in element 411. Instead, the cited disclosure refers to sequence information buffer 30 (Figure 2) and message information buffer 40 (not shown) in which information is stored during step 303 (Figure 4). (See, Matsui col. 6, lns. 2-6). Therefore, the Examiner's argument regarding parameters or variables alleged to be in messages stored in buffers 60/70 is not supported by the cited disclosure. Instead, the Examiner improperly mixes the discussion of unrelated messages/scenarios stored in different buffers (30/40, 60/70) that are created and stored by different processes (303, 411) to achieve a desired prior art teaching. Therefore, this interpretation of the Matsui reference is not reasonable, and it is not obvious or predictable that one of ordinary skill in the art would modify the system to fit the characterization set forth in the Answer.

### **III. Lack of claim construction**

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

In construing means-plus-function claim language in accordance with 35 U.S.C. § 112, ¶ 6, one must "look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure." *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994).

Claim 11 is an apparatus claim that recites five separate means-plus-function elements. The Examiner's rejection has not set forth a prima facie case of obviousness with respect to claim 11 because the Examiner has not interpreted the various means-plus-function limitations. The Office Actions, the Advisory Action and the Examiner's Answer fail to

clearly point out the structure in the references that meet the means-plus-function limitations of claim 11. Instead, the Examiner has simply stated that “Claim 11 is the means claim of claim 1 and is similarly rejected under the same rational.” (Final Office Action at 6, Examiner’s Answer at 7; *see also*, Advisory Action at 2). The rejection of claim 1 merely alleges that certain functions are performed without identifying corresponding structures for each of the functions. Therefore, the Examiner’s rejection of claim 11 should be reversed because the mean-plus-function limitations must first be construed before application of the prior art to the claims.

#### **IV. Conclusion**

For all the reasons discussed above, the rejections of claims 1-11 should be reversed.

Respectfully submitted,

August 25, 2010  
Date

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